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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,921	01/25/2002	Eiichi Takata	36856.617	7243

7590

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EXAMINER

KIM, PAUL D

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 02/04/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,921

Applicant(s)

TAKATA ET AL.

Examiner

Paul D Kim

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/546,862.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The phrase “further comprising the step of ion bombarding...after the step of packaging” recited in lines 1-3 of claim 9 does not disclose in the specification.

Claim Objections

2. Claims 7 and 10-12 are objected to because of the following informalities:

Re. Claim 7: The phrase “the thickness of said interdigital transducer” recited in lines 1-2 should be changed to --a thickness of said at least one interdigital transducer--.

Re. Claim 10: The phrase “the thickness of said metal film” recited in lines 1-2 should be changed to --a thickness of said metal film--.

Re. Claim 12: The phrase “at least one of...” recited in line 3 is objected because when materials recited in a claim are so related as to constitute a proper **Markush group**, they may be recited in the conventional manner, or alternatively. For example, if “wherein R is a material selected from the group consisting of A, B, C and D” is a proper limitation, then “wherein R is A, B, C or D” shall also be considered proper (see MPEP 2173.05(h)).

The phrase "said interdigital transducers" recited in lines 3-4 should be changed to --said at least one of the interdigital transducers--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6-12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

According to the limitation recited in lines 4-5 of claim 6, the metal film is disposed on the piezoelectric body. It is unclear as to what happens to this metal film in the claimed invention. It is also unclear why the metal film is needed in the claimed invention. Also, the recitations in claims 10 and 11 are unclear as to why these extra steps such as adjusting thickness of the metal film and adjusting thickness by etching using a wet etchant are performed. There is no further limitation how to use the metal film in the claimed invention.

Allowable Subject Matter

5. Claims 6-12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

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6. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to disclose the claimed invention such as "simultaneously etching the at least one interdigital transducer and the piezoelectric body" recited in claim 6.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Koshido (US PAT. 6,358,429), Koshido (US PAT. 6,204,190), and Ichigawa et al. (US PAT. 5,996,199) are cited to further show the state of the art with respect to method of manufacturing a surface acoustic wave device.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D Kim whose telephone number is 703-308-8356. The examiner can normally be reached on Tuesday-Friday between 8:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5648.


Paul D. Kim
Examiner
Art Unit 3729